

### REMARKS

In the September 17, 2003 Office Action, claims 1-8 and 11-21 stand rejected in view of prior art, while claims 9-10 were indicated as containing allowable subject matter. No other objections or rejections were made in the Office Action.

#### *Status of Claims and Amendments*

In response to the September 17, 2003 Office Action, Applicant has amended claims 1-2, 11-13, 15-18 and 20 as indicated above, and canceled claim 14 without prejudice or disclaimer. Applicant has amended claims 1 and 2 to more clearly define the present invention over the prior art of record. Also, Applicant has amended claims 11 and 12 to rewrite these claims as dependent claims of independent claim 1. In addition, Applicant has amended claims 13, 15-18 and 20 for conformity of claim language and/or to change the dependencies of these claims. Thus, claims 1-13 and 15-21 are pending, with claims 1, 2 and 9 being the only independent claims. Entrance and consideration of the above amendments are respectfully requested. Also, reexamination and reconsideration of the pending claims are respectfully requested in view of the above amendments and the following comments.

#### *Interview Summary*

Applicant's representative wishes to thank Examiner McAnulty for the opportunity to discuss the above-identified patent application during the interview of December 12, 2003. Applicant's representative pointed out that the alleged second link 3 of the Juy patent has an axis along the hinge pin 5 of the Juy patent. The parties then reached an agreement that the first flange and the second flange of the present invention are on opposite sides of a plane which is perpendicular to a second pivot axis and passes through a center axis of a curved mounting surface. See Fig. 8 of the present application. In contrast, the parties agreed during the interview that *the first and second flanges* of U.S. Patent No. 3,730,012 (Juy) *appear to both be on the same side* of such a plane. See Fig. 3 of the Juy patent. The Examiner indicated that further consideration may be necessary. In response, Applicant has amended independent claim 1 to recite a mounting portion configured and arranged relative to first and second mounting flanges to define a *plane* that is *perpendicular to a second pivot axis* and *passes between* the first and second mounting flanges *and through a center axis* of a curved mounting surface with *the first mounting flange being located on a first side of the plane and the second mounting flange being located on a second side of the plane* that is

opposite to the first side of the plane. Applicant respectfully asserts that independent claim 1, as now amended, is allowable over the prior art of record.

The parties also agreed during the interview that *a first pivot axis of the Juy patent is not substantially coincidence with a center plane* of the frame tube (T) which is substantially parallel to the first pivot axis. See Fig. 5 of the Juy patent. The Examiner indicated that further consideration may be necessary. In response, Applicant has amended independent claim 2 to recite a fixed member being configured with *a first pivot axis being substantially coincident with a center plane of a frame portion* that extends substantially parallel to the first pivot axis. Applicant respectfully asserts that independent claim 2, as now amended, is allowable over the prior art of record.

No agreement was reached during the interview as to whether any of the dimensional limitations of claims 2-8 and 11-21 are non-obvious over the prior art. In addition, the parties agreed during the interview that Applicant will respond in due course.

#### ***Drawings***

Applicant submitted four (4) *replacement sheets of drawings*, including Figures 2, 3, 6(a), 6(b) and 7 on June 13, 2003, which were *not* indicated as being approved or disapproved. These replacement sheets of drawings are assumed to have already been approved and entered. In any event, Applicant respectfully requests acknowledgment of the receipt of these replacement sheets of drawings, and acknowledgement of the approval and entrance of these replacement sheets of drawings.

#### ***Rejections - 35 U.S.C. §102***

In the numbered paragraphs 1 and 2 of the Office Action, claim 1 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,730,012 (Juy). In response, Applicant has amended independent claim 1 to more clearly define the present invention over the prior art of record.

In particular, independent claim 1 now clearly recites a front derailleur for a bicycle including

a mounting portion being configured and arranged relative to first  
and second mounting flanges to define *a plane* that is  
*perpendicular to a second pivot axis* and *passes between* the  
first and second mounting flanges *and through a center axis* of  
a curved mounting surface *with the first mounting flange*

being located *on a first side of the plane and the second mounting flange* being located *on a second side of the plane* that is opposite to the first side of the plane.

Clearly, this structure is *not* anticipated by the Juy patent or any other prior art of record. In particular, the Juy patent *fails* to disclose a *first mounting flange* being located *on a first side of a plane and a second mounting flange* being located *on a second side of the plane that is opposite to the first side of the plane*, as now set forth in independent claim 1.

Moreover, the Juy patent *fails* to disclose a mounting portion being *configured and arranged* relative to first and second mounting flanges *to define a plane* that is *perpendicular to a second pivot axis* and *passes between* the *first and second mounting flanges and through a center axis* of a curved mounting surface, as now set forth in independent claim 1. Thus, the Juy patent *fails* to disclose the unique arrangement of the mounting portion and the first and second mounting flanges, as claimed. It is well settled under U.S. patent law that for a reference to anticipate a claim, the reference must disclose each and every element of the claim within the reference. Therefore, Applicant respectfully submits that independent claim 1, as now amended, is *not* anticipated by the prior art of record. Withdrawal of this rejection is respectfully requested.

#### ***Rejections - 35 U.S.C. §103***

In the numbered paragraphs 3 and 4 of the Office Action, claims 2-8 and 11-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,730,012 (Juy). In response, Applicant has amended independent claims 1 and 2 as mentioned above. Also, Applicant has amended claims 11 and 12 to make these claims dependent from independent claims 1. In addition, Applicant has amended claims 13, 15-18 and 20 to change the dependencies of these claims, and canceled claim 14 without prejudice or disclaimer.

More specifically, independent claim 2 now clearly recites a front derailleur for a bicycle including

a first link pivotally coupled to a fixed member at a first pivot point for rotation about a first pivot axis, the fixed member being configured with *the first pivot axis being substantially coincident with a center plane of a frame portion* that extends substantially parallel to the first pivot axis.

Clearly this arrangement is **not** disclosed or suggested by the Juy patent or any other prior art of record. As mentioned above, the parties agreed during the interview that **a first pivot axis of the Juy patent is not substantially coincidence with a center plane** of the frame tube (T) which is substantially parallel to the first pivot axis. See Fig. 5 of the Juy patent. As such, the Juy patent **fails** to disclose or suggest the unique arrangement of the first pivot axis and the frame portion, as now set forth in independent claim 2.

It is well settled in U.S. patent law that the mere fact that the prior art can be modified does **not** make the modification obvious, unless the prior art **suggests** the desirability of the modification. Accordingly, the prior art of record lacks any suggestion or expectation of success for modifying the Juy patent to create the Applicant's unique arrangement of the first pivot axis and the frame portion, as now set forth in independent claim 2.

Moreover, Applicant believes that the dependent claims 3-8, 13 and 17 are also allowable over the prior art of record in that they depend from independent claim 2, and therefore are allowable for the reasons stated above. Also, the dependent claims 3-8, 13 and 17 are further allowable because they include additional limitations.

Therefore, Applicant respectfully requests that this rejection be withdrawn in view of the above comments and amendments.

Turning now to claims 11-12, 16 and 18-21, these claims now depend from independent claim 1 and now require a mounting portion being configured and arranged relative to first and second mounting flanges to define **a plane** that is **perpendicular to a second pivot axis** and **passes between** the first and second mounting flanges **and through a center axis** of a curved mounting surface **with the first mounting flange being located on a first side of the plane and the second mounting flange being located on a second side of the plane** that is opposite to the first side of the plane.

Clearly this arrangement is **not** disclosed or suggested by the Juy patent or any other prior art of record. As mentioned above with regard to the argument for independent claim 1, the Juy patent **fails** to disclose the unique arrangement of the mounting portion and the first and second mounting flanges, as claimed. More specifically, Applicant respectfully asserts that the Juy patent **fails** to disclose or suggest the unique arrangement of the mounting portion and the first and second mounting flanges, as now set forth in claims 11-12, 16 and 18-21.

It is well settled in U.S. patent law that the mere fact that the prior art can be modified *does not* make the modification obvious, unless the prior art *suggests* the desirability of the modification. Accordingly, the prior art of record lacks any suggestion or expectation of success for modifying the Juy patent to create the Applicant's unique arrangement of the mounting portion and the first and second mounting flanges, as now set forth in claims 11-12, 16 and 18-21.

Therefore, Applicant respectfully requests that this rejection be withdrawn in view of the above comments and amendments.

Turning now to claim 15, this claim *now depends from independent claim 9*, which was indicated as being *allowed* in the September 17, 2003 Office Action. Thus, Applicant believes that the dependent claim 15 is allowable over the prior art of record in that it depends from independent claim 9, and therefore is allowable for the reasons stated above. Also, the dependent claim 15 is further allowable because it includes additional limitations.

Therefore, Applicant respectfully requests that this rejection be withdrawn in view of the above comments and amendments.

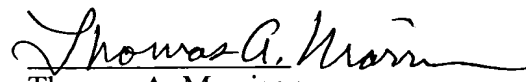
***Allowable Subject Matter***

In the numbered paragraph 5 of the Office Action, claims 9 and 10 were indicated as allowed. Applicant wishes to thank the Examiner for this indication of allowable subject matter and the thorough examination of this application.

\* \* \*

In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1-13 and 15-21 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

Respectfully submitted,

  
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